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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/171,854	10/22/1998	STEFAN JOOS	3528.38.USOO	8548

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EXAMINER
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SISSON, BRADLEY L

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SM-  
**Advisory Action**

Application No.

09/171,854

Applicant(s)

JOOS ET AL.

Examiner

Bradley L. Sisson

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 12 March 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-7.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

  
Bradley L. Sisson  
Primary Examiner  
Art Unit: 1634

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's response of 12 March 2004 (hereinafter the response) fails to present convincing evidence that the claimed invention is both fully enabled and is adequately described so as to fulfill the requirements of 35 USC 112, first paragraph. At page 2 of the response applicant asserts "[a] person skilled in the art knows what kind of starting materials are required for a particular purpose." Such assertions are conclusory. Further, the need for applicant, not the public, to identify the starting materials is well settled; *Genentech v. Novo Nordisk A/S* 42 USPQ 1001.

At page 2 of the response applicant asserts that the one and only example is "useful for the analysis of any kinds of cells." Applicant does not, however, teach how this one example is to be modified, altered or adapted so that material for any life form, trees, moss, bone, bacteria, etc., are to be analyzed.

At page 2, last paragraph of the response applicant asserts that the examiner has misconstrued the claims as they have been amended and no longer positively recite that they are directed to DNA-based disease diagnosis. This argument has been fully considered and has not been found persuasive as the claims have been and continue to be interpreted as encompassing all manner of "detecting chromosomal overrepresentations," including those that relate to DNA-based disease diagnosis.

Page 2, bridging to page 3 of the response applicant asserts in the alternative "particular kinds of chromosomal overrepresentations that could be found in particular diseases were already known for a person skilled in the art." This argument has been fully considered and has not been found persuasive as the claims are not limited to "particular kinds of chromosomal overrepresentations." Further, the specification does not adequately describe just which "particular chromosomal overrepresentations" the claimed method is limited to.

At page 3 of the response applicant asserts that "[t]here is no doubt that the instructions given in the example do not only apply to the particular cell line of the example, but also can be generally applied." Again, applicant's arguments are conclusory. No evidence is presented as to how the original disclosure teaches how the method steps of this one example are to be modified and extrapolated so to be applicable to any cell sample.

At page 4 of the response applicant directs attention to "Example 1, step 4" found in the specification as directing attention to publications that have been identified in the disclosure.

A review of the disclosure, esp. page 3, last paragraph, bridging to page 4, first four lines, directs attention to certain documents and specifically states that "[t]he teachings of these references are herein incorporated by reference." Such language, however, is not sufficient for a proper incorporation by reference in that no particular part of the cited document has been identified as having been incorporated by reference. Accordingly, the documents have not been construed as having been incorporated by reference and therefore cannot be relied upon for satisfaction of 35 USC 112, first paragraph, requirements. As set forth in *Advanced Display Systems Inc. v. Kent State University* (Fed. Cir. 2000) 54 USPQ2d at 1679:

Incorporation by reference provides a method for integrating material from various documents into a host document—a patent or printed publication in an anticipation determination—by citing such material in a manner that makes it clear that the material is effectively part of the host document as if it were explicitly contained therein. See *General Elec. Co. v. Brenner*, 407 F.2d 1258, 1261-62, 159 USPQ 335, 337 (D.C. Cir. 1968); *In re Lund*, 376 F.2d 982, 989, 153 USPQ 625, 631 (CCPA 1967). **To incorporate material by reference, the host document must identify with detailed particularity what specific material it incorporates and clearly indicate where that material is found in the various documents.** See *In re Seversky*, 474 F.2d 671, 674, 177 USPQ 144, 146 (CCPA 1973) (providing that incorporation by reference requires a statement "clearly identifying the subject matter which is incorporated and where it is to be found"); *In re Saunders*, 444 F.2d 599, 602-02, 170 USPQ 213, 216-17 (CPA 1971) (reasoning that a rejection or anticipation is appropriate only if one reference "expressly incorporates a particular part" of another reference); *National Latex Prods. Co. v. Sun Rubber Co.*, 274 F.2d 224, 230, 123 USPQ 279, 283 (6<sup>th</sup> Cir. 1959) (requiring a specific reference to material in an earlier application in order to have that material considered a part of a later application); cf. *Lund*, 376 F.2d at 989, 13 USPQ at 631 (holding that **a one sentence reference to an abandoned application is not sufficient to incorporate from the abandoned application into a new application**). (Emphasis added.)

At page 4, last paragraph, applicant asserts that "[f]or the same Reasons stated above, the S 112, first paragraph, enabling rejection [sic, written description] rejection of claims 1-7 should be withdrawn." This assertion has been fully considered and has not been found persuasive. It is well settled that it is not enough that applicant provides a description that renders the claimed invention obvious. Applicant must provide a written description of all elements of the claimed invention. Such has disclosure is not present in the originally filed application. Attention is directed to the decision in *University of Rochester v. G.D. Searle & Co.* 68 USPQ2D 1424 (Fed. Cir. 2004) at 1428:

To satisfy the written-description requirement, the specification must describe every element of the claimed invention in sufficient detail so that one of ordinary skill in the art would recognize that the inventor possessed the claimed invention at the time of filing. *Vas-Cath*, 935 F.3d at 1563; see also *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 [41 USPQ2d 1961] (Fed. Cir. 1997) (patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention"); *In re Gosteli*, 872 F.2d 1008, 1012 [10 USPQ2d 1614] (Fed. Cir. 1989) ("the description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed"). Thus, an applicant complies with the written-description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572.

For the above reasons, and in the absence of convincing evidence to the contrary, the rejections are maintained.